

REMARKS

By this amendment, claims 1, 4, 6, and 9 have been amended. This amendment is made to more clearly recite the claimed invention, does not add prohibited new matter and is fully supported by the specification. Reconsideration and withdrawal of the rejections set forth in the outstanding Office Action are respectfully requested in view of the following remarks.

Rejection under 35 U.S.C. § 112, second paragraph

The Office Action rejects claims 1, 2, 4-7, 9, and 10 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Office Action asserts that the claim phrases “high-speed instruction” and “low-speed instruction” are indefinite, alleging that these terms are open to multiple interpretations. Without agreeing with or acquiescing to the rejection, Applicants note that claims 1, 4, 6, and 9 have been amended to recite “wherein the rate of tempo of game music and the rate of formation of said frame images and said determined game progress is increased, when a player inputs a first predetermined instruction, and wherein the rate of tempo of the game music and the rate of formation of said frame images and said determined game progress is decreased, when a player inputs a second predetermined instruction.” Furthermore, Applicants note that the exemplary embodiments in the specification support the aforementioned claim amendments (*see, e.g.*, paragraphs [0234] and [0235] of the published version of the present specification). Applicants submit the scope of the claims is sufficiently defined, and respectfully request withdrawal of the ground of rejection.

Rejection under 35 U.S.C. § 103(a)

The Office Action rejects 1, 2, 4-7, 9, and 10 under 35 U.S.C. § 103(a) over Deering (U.S. Patent No. 6,313,838, hereinafter “DEERING”). Applicants submit that DEERING does not render obvious the claimed subject matter of claims 1, 2, 4-7, 9 and 10 for at least the reasons provided below. Thus, Applicants respectfully request reconsideration and withdrawal of all outstanding rejections, and an indication of the allowability of claims 1, 2, 4-7, 9 and 10 in the next Office correspondence.

In the outstanding Office Action, Applicants note that the Examiner does not argue that DEERING discloses or even suggests the recitation “wherein the rate of tempo of game music and the rate of formation of said frame images and said determined game progress is increased when a player inputs a high-speed instruction,” as recited in independent claims 1, 4, 6, and 9. Rather, the Office Action simply asserts that this feature would be within the skill of one skilled in the art (*see* page 3, paragraph 2, of the outstanding Office Action) without support for this conclusion or clear articulation of the reasons behind such a conclusion.

In response, Applicants submit that the rejection is improper because the Examiner has failed to sufficiently establish that DEERING, or any other art, discloses or renders obvious the elements of the claimed invention. Applicants further assert that the Examiner’s unilateral conclusion (without any supporting evidence) that a feature is a design choice, is inadequate to render the claims unpatentable. As discussed in section 2142 of the MPEP:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be

sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Thus, in order to establish a *prima facie* case of obviousness, Applicants submit that the Office Action must explicitly argue the reasons and/or provide support for the conclusion that all of the elements of the claimed invention are disclosed and/or rendered obvious by the cited art. In the absence of citations to the art or clear articulation of the reasons that would lead the Examiner to a conclusion of obviousness, the burden to establish a *prima facie* case of obviousness has not been satisfied.

Applicants submit that the claim element "wherein the rate of tempo of game music and the rate of formation of said frame images and said determined game progress is increased when a player inputs a high-speed instruction" is not simply a "design choice," as suggested by the Examiner (*see* page 3, paragraph 2, of the outstanding Office Action). Rather, the aforementioned feature of the claimed invention allows a player to control the rate of tempo of game music and the rate of formation of frame images (via a high-speed or low-speed instruction), and is not disclosed by the cited art. Furthermore, Applicants submit that one skilled in the art would not have proper guidance or reasons to arrive at the claimed invention, based on the teachings of DEERING and the aforementioned deficiencies therein.

For at least these reasons, Applicants submit that the Office Action has not established a *prima facie* case of obviousness, and respectfully request reconsideration and withdrawal of the outstanding Section 103 rejections of claims 1, 2, 4-7, 9 and 10 as being anticipated by DEERING, and allowance of the instant application to mature into a U.S. patent.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that Examiner's rejections should be withdrawn. Entry and consideration of the present amendment, reconsideration of the outstanding Office Action, and allowance of the present application and all of the claims therein are respectfully requested and now believed to be appropriate.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Commissioner determine that an extension of time is required in order to render this response timely and/or complete, a formal request for an extension of time, under 37 C.F.R. §1.136(a), is herewith made in an amount equal to the time period required to render this response timely and/or complete. The Commissioner is authorized to charge any required extension of time fee under 37 C.F.R. §1.17 to Deposit Account No. 19-0089.

Should the Examiner have any questions, please contact the undersigned at the telephone number provided below.

Respectfully Submitted,
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